

**REMARKS**

In the Office Action of May 13, 2005,<sup>1</sup> claims 17-20 were rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claim 1 of U.S. Patent No. 6,742,163 B1 to *Ono et al.* in view of U.S. Patent No. 5,873,107 to *Borovoy et al.* ("*Borovoy*").

Although disagreeing with the obviousness-type double patenting rejection, in an effort to advance prosecution, Applicants file a Terminal Disclaimer<sup>2</sup> concurrently with this paper, obviating the rejection. Applicants do not acquiesce to any statement or characterization in the Office Action regarding *Borovoy*.

Applicants request reconsideration of this application in view of the attached Terminal Disclaimer, withdrawal of the obviousness-type double patenting rejection, and the timely allowance of pending claims 17-20.

Regarding the Information Disclosure Statement (IDS) filed February 23, 2004

The Examiner crossed out certain documents listed on the Form PTO 1449 submitted with the IDS filed February 23, 2004 (a copy of the crossed out form is attached). In the Office Action, the Examiner indicated that the crossed out documents were not considered "due to missing a copy of such references" (Office Action, page 2).

As set forth in 37 C.F.R. § 1.98(d), documents listed in an IDS are not required to be provided if they were previously submitted to, or cited by, the Office in an earlier application, provided that the earlier application is properly identified in the IDS and is relied on for an

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<sup>1</sup> The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

<sup>2</sup> Applicants point out that: "[t]he filing of a terminal disclaimer to obviate a rejection based on nonstatutory double patenting is not an admission of the propriety of the rejection." M.P.E.P. § 804.02(II), 8<sup>th</sup> Ed., Aug. 2001, p. 800-32 (citing *Quad Environmental Tech. Corp. v. Union Sanitary Dist.*, 946 F.2d 870 (Fed. Cir. 1991)). As M.P.E.P. § 804.02(II) indicates, "[t]he Court indicated that the 'filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection.'" *Id.*

earlier effective filing date under 35 U.S.C. § 120 and provided that the IDS submitted in the earlier application complies with 37 C.F.R. § 1.98(a)-(c).

In this case, the documents crossed out by the Examiner were previously submitted and/or cited by the Examiner in a prior application, Application No. 09/016,488, filed January 30, 1998, (issued as U.S. Patent No. 6,742,163 B1). The prior application was identified in the February 23, 2004, IDS and is relied upon by Applicants for the benefits of 35 U.S.C. § 120. Further, Applicants submit that the IDS submitted in the earlier application was proper. Accordingly, Applicants should not be required to submit copies of the crossed out documents and the Examiner should consider those documents. Nonetheless, Applicants attach herewith courtesy copies of the crossed out Japanese patent documents along with English language Abstracts for those documents. (Applicants are unable to locate a copy of the other crossed out document at this time.)


With this paper, Applicants submit a copy of the Form PTO 1449 submitted with the IDS filed February 23, 2004. Applicants request that the Examiner consider the crossed out documents and indicate that they were considered by making appropriate notations on the attached form.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 15, 2005

By:   
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